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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,392	11/08/2001	Graham Smith	00167-441001	5656

7590

10/06/2003

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EXAMINER

REIP, DAVID OWEN

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,392

Applicant(s)

SMITH, GRAHAM

Examiner

David O. Reip

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-15, 17, 19, 21-24, 28, 29 and 31 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 25-27 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's request for reconsideration, see paper # 9, filed 9/4/03, with respect to the rejection(s) of claim(s) 1-31 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Steiner, U.S. Pat. No. 6,508,830.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12-15, 17, 19, 21-24, 28, 29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Steiner, U.S. Pat. No. 6,508,830. Fig. 1 of Steiner shows a bone anchor having all the limitations as recited in the above listed claims, including: a unitary anchor body 12; a restrictor 28 including sloped surfaces 25 and 27; an opening 22; a pair of legs 24 and 26; a "post" (the reduced section or groove 17/20 around the middle of the anchor body); and a bone engaging ridge 18. Note that the examiner sees the restricted movement of a flexible member/suture caused by the

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restrictor 28 is anticipated by the reference as follows: When viewing the anchor as shown in Fig. 1, establish that the rounded top 14 of the anchor is considered "up," and that the insertion end of the anchor at the V-shaped notch 28 is considered "down."

Next, envision a loop of suture looped around the insertion tip of the anchor so that a portion of the loop rests in the V-shaped notch at 28 and the free ends of the suture are held together in one's hand above the top of the anchor. By pulling "up" (e.g. the first direction) on the suture loop, the length of suture resting in the V-shaped notch is forced upward into the notch, both compressing the suture and slightly spreading the leg portions 24 and 26 apart until the loop of suture "snaps" into the opening 22. If one then reverses the orientation of the hand-held free ends of the suture loop so that the hand is now below the insertion end of the anchor, it can be seen by pulling "down" (e.g. the second, opposite direction) on the loop will only force the loop into the bottom portion of the opening 22, but further movement of the suture loop in the "down" direction will be restricted by the structure of the "restrictor" 28.

***Allowable Subject Matter***

Claims 16 and 18 are allowed.

Claims 10, 11, 25-27, and 30 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip at (703) 308-3383. The examiner can normally be reached Mon-Thu and every other Fri from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The fax number for this Technology Center is (703) 872-9306. The examiner can also receive unofficial direct-to-computer faxes at 703-746-3310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858.

A handwritten signature in black ink, appearing to read "David O. Reip". The signature is stylized with a large, looping "D" and a cursive "Reip".

David O. Reip  
Primary Examiner  
October 1, 2003